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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,029	12/12/2003	Ehud Amir	1662/6040761	2457

26646 7590 10/02/2006

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EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,029

Applicant(s)

AMIR ET AL.

Examiner

EBENEZER SACKY

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 1-64 and 68-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 65-67 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Status of the Claims

Claims 1-84 are pending.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed on 06/09/04 is acknowledged and has been entered into the file. A signed copy of the 1449 is attached herewith.

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Response to Restriction

Applicant's election without traverse of Group XII claims 65-67 in the reply filed on 07/18/06 is acknowledged. Thus, claims 1-64 and 68-84 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to non-elected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 65-67 are of indeterminate scope because there are no x-ray diffraction peaks in the claims. Additionally, the metes and bounds of "at least one characteristic of form CX" cannot be readily ascertained. What exactly is the form CX?

According to Brittain, a publication attached and cited herewith state:

For routine work...one typically compares the powder pattern of the analyte to that of reference materials to establish polymorphic identity. Since every compound produces its own characteristic powder diffraction pattern owing the unique crystallography of its structure, powder X-ray diffraction is clearly the most powerful and fundamental tool for a specification of the polymorphic identity of the analyte. Moreover, the USP general chapter on X-ray diffraction states that the identity is established if the scattering angles of the ten strongest reflections

obtained for an analyte agree to within ± 0.20 degrees with that of the reference material, and if the relative intensities of these reflections do not vary by more than 20 percent. (see Brittain in Polymorphism in Pharmaceutical Solids, p.236). Thus, the absence of any

peaks of the X-ray diffraction pattern renders the claim indefinite because such absence

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is not specific enough to particularly point out and distinctly claim the product that applicants regard as their invention. At the very least, the claims should be amended to conform to the general practice in the art according to Brittain, i.e., include at least data for the 10 strongest peaks. Moreover, additional data such as water content and DSC scans, if supported in the specification, could also be included in order to particularly point and distinctly claim the subject matter, which applicants regard as their invention. Note "cooling" has been misspelled under sub-section (b). Correction is required. It is suggested that the formula for gatifloxacin of claim 65 be inserted into the claim for clarity.


U.S. Patent number 5,880,283 is cited to show the state of the art. The said reference teaches the preparation of an acid sesquihydrate of the compound.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS
September 20, 2006


Joseph K. McKane

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Supervisory Patent Examiner
Art Unit 1626, Group 1600
Technology Center 1